

### Remarks

Claims 1-6, 9-11 and 13-18 are currently pending in the present patent application. Claims 7-8 and 12 were previously cancelled. Claim 1 has been amended. Claim 19 has been added.

### Claims 1-6, 9-11 and 13-18, Rejected Under 35 USC § 103(a)

Claims 1-6, 9-11 and 13-18 have been rejected under 35 USC § 103(a) as being unpatentable over Hellebust (U.S. 2005/0248437 A1, hereinafter *Hellebust*) in view of Wagner et al. (U.S. 2004/0259598 A1, hereinafter *Wagner*).

#### *Legal Standards.*

The Examiner, by citing references and asserting a reason for combining elements from the references, has elected to base rejection of claims 1-6, 9-11 and 13-18 upon a purported teaching, suggestion of motivation to combine elements from *Hellebust* and *Wagner*. The only pending grounds for rejection, therefore, are based upon a “teaching, suggestion or motivation” analysis. In the event that the Examiner chooses to consider a different avenue for rejection, this would be a new ground for rejection not due to any action by Applicant. Applicant has a right to be heard on any new ground for rejection.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (MPEP 2143)

The above principles pertaining to the Examiner’s duty are in harmony with the decision from the United States Supreme Court, *KSR Int’l Co. v. Teleflex Inc.*, No. 04-1350 (April 30, 2007). The Supreme Court’s *KSR* decision characterized a “teaching, suggestion or motivation” analysis as “a helpful insight.” *KSR* slip op. at 14-15. When the Examiner chooses to base a rejection upon a teaching, suggestion or motivation analysis, the Examiner must satisfy the requirements of such an analysis. In particular, the Examiner must

demonstrate with evidence and reasoned argument that there was a teaching, suggestion or motivation to select and combine features from the cited references. *E.g.*, *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Moreover, the prior art must suggest the desirability of the combination, not merely the feasibility. *In re Fulton*, 73 USPQ2d 1141, 1145 (Fed. Cir. 2004).

As will be discussed below, the cited references fail to disclose or suggest all of the elements recited in the claims. When the cited references fail to disclose or suggest all of the elements recited in the claims, then combining elements from the references would not yield the claimed subject matter, regardless of the extent of any teaching, suggestion or motivation. Applicant further respectfully reminds the Examiner that, even after KSR, the following legal principles are still valid, having been endorsed by the Supreme Court or having been unaffected by its decision: (1) the USPTO still has the burden of proof on the issue of obviousness; (2) the USPTO must base its decision upon evidence, and it must support its decision with articulated reasoning (slip op. at 14); (3) merely demonstrating that all elements of the claimed invention exist in the prior art is not sufficient to support a determination of obviousness (slip op. at 14-15); (4) hindsight has no place in an obviousness analysis (slip op. at 17); and (5) Applicant is entitled to a careful, thorough, professional examination of the claims (slip op. at 7, 23, in which the Supreme Court remarked that a poor examination reflected poorly upon the USPTO).

*The Cited References Fail to Disclose or Suggest Each and Every Claim Element.*

The Independent Claims.

The cited references fail to disclose or suggest all of the elements recited in the independent claims. Consequently, the Examiner has not met the Examiner's legal burden of proof. Even if there is a teaching, suggestion or motivation supported by the record (a point that the Applicant does not concede), such an impetus cannot cure this defect in the Examiner's case. Regardless of what impetus one skilled in the art might or might not have had, one skilled in the art could not combine the elements in the references to create the claimed combination of elements.

It is respectfully submitted that upon considering the disclosures of *Hellebust* and *Wagner*, whether individually or in combination, one skilled in the art would not consider

providing “a first indicator of the presence of a number of unread electronic messages received” and “enabling scanning of the unread electronic messages received without reading” and then “altering said first indicator to provide a second indicator at the location on the visual display that provides a visually distinguishable annunciation by altering said first indicator that new unread electronic messages have been received since the unread electronic messages received were last scanned” as recited in amended claim 1 (and similarly in claims 4 and 11), as neither of the cited references individually, nor in combination disclose or suggest such elements.

Likewise, upon considering the disclosures of *Hellebust* and *Wagner*, whether individually or in combination, one skilled in the art would not consider providing “a first indicator of the presence of a number of unread electronic messages received, the first indicator including a count to indicate the number of unread electronic messages received” and “enabling scanning of the unread electronic messages received without reading” and then “providing a second indicator at the location on the visual display, the second indicator including a count to indicate the number of unread electronic messages received and an indication that at least one of the unread electronic messages has been received since the unread electronic messages received were last scanned” (emphasis added) as recited in new claim 19.

*Hellebust* is directed to a system for displaying, organizing, and prioritizing information on a wireless device (abstract). The system can display the number of voice mails, e-mails, pages, and Internet information alerts that have been received by the wireless device during a specified time period (abstract). The system analyzes incoming messages, such as voice mails, emails, pages, and internet alerts to determine classification information based on a retrieved rule set (see FIGS. 2-3). The display of the wireless device can be updated to inform the user of the results of such analysis. *Hellebust* only vaguely mentions that the display of the wireless device may be updated to reflect that a new message has arrived such as by “the display of standard or user-friendly icons or sounds, the display of summarized messages by type, or the display of the actual message itself” as stated in the last sentence of paragraph [0011]. As conceded by the Examiner on page 8 of the Office Action, *Hellebust* does not disclose “a first indicator of the presence of a number of unread electronic messages received” as recited in claim 1.

Additionally, *Hellebust* fails to provide any further teaching as to what the update to the display may actually comprise or how such update is carried out.

Furthermore, *Hellebust* provides no disclosure of performing any action relative to messages after they are characterized when initially received, and certainly does not disclose or suggest “enabling scanning of the unread electronic messages received without reading”, let alone “altering said first indicator to provide a second indicator at the location on the visual display that provides a visually distinguishable annunciation by altering said first indicator that new unread electronic messages have been received since the unread electronic messages received were last scanned” as recited in claim 1 (and similarly in claims 4 and 11) or “providing a second indicator at the location on the visual display, the second indicator including a count to indicate the number of unread electronic messages received and an indication that at least one of the unread electronic messages has been received since the unread electronic messages received were last scanned” (emphasis added) as recited in new claim 19.

The Examiner contends that the abstract of *Hellebust*, in stating “the present invention allows the wireless device user to see at a glance what kind of information has been received and is being stored on the wireless device” discloses “enabling scanning of the unread electronic messages received without reading” as recited in claim 1. Clearly such a statement is merely a vague generalization of a supposed benefit of the teaching of *Hellebust* and **does not** actually disclose or whatsoever suggest “enabling scanning of the unread electronic messages received without reading” as recited in claim 1, and similarly in claims 4, 11 and 19. If anything, *Hellebust* explicitly teaches away from such claim feature by disclosing allowing incoming messages “to be searched for key words or phrases”, and also disclosing prioritizing messages based on “message origin” (i.e., the sender of the message) (see Para [0014]). In other words, *Hellebust* explicitly discloses scanning unread messages by reading part of or the entire message, which is in direct contrast to the claim feature recited in claim 1 (and similarly claims 4, 11 and 19).

To compensate for the deficiencies of *Hellebust*, the Examiner relies upon the teaching of *Wagner*, directed toward a context based mobile device display. However *Wagner* is not concerned with, and like *Hellebust* previously discussed, provides no disclosure or suggestion of “enabling scanning of the unread electronic messages received

without reading.” Absent such disclosure in either cited reference, **plainly the references do not disclose or even contemplate** “altering said first indicator to provide a second indicator at the location on the visual display that provides a visually distinguishable annunciation by altering said first indicator that new unread electronic messages have been received since the unread electronic messages received were last scanned” as recited in claim 1 (and similarly in claims 4 and 11) or “providing a second indicator at the location on the visual display, the second indicator including a count to indicate the number of unread electronic messages received and an indication that at least one of the unread electronic messages has been received since the unread electronic messages received were last scanned” (emphasis added) as recited in new claim 19.

As the cited art fails to disclose or suggest all the elements recited in claims 1, 4, 11, and 19 such claims are patentably distinguishable from *Hellebust* and *Wagner* when combined and thus should be allowed in light of the cited art.

Since independent claims 1, 4 and 11 are believed to be allowable over *Hellebust* and *Wagner* for the reasons provided above, dependent claims 2-3, 5-6, 9-10 and 13-18 which depend therefrom are also believed to be allowable as a matter of law as well.

*The Examiner has Relied Upon Improper Rationale For Combining Hellebust and Wagner.*

The Examiner has Relied Upon Improper Hindsight.

Regarding the Examiner’s contention that the present claimed concept would have been obvious to one skilled in the art in light of the teaching of *Hellebust* and *Wagner*, it is respectfully submitted that even if the cited art did in fact disclose all of the elements presented in the claims (a point which Applicant clearly does not concede), the rationale relied upon by the Examiner is improper.

In attempting to provide support for combining the teaching of *Hellebust* and *Wagner*, the Examiner has clearly relied upon impermissible hindsight reasoning. As previously discussed, neither reference discloses or suggests “scanning of the unread electronic messages received without reading.” As such, clearly the combination of such references would not provide motivation to one skilled in the art at the time the invention was made to alter an indicator to indicate that new unread electronic messages have been received since the unread electronic messages received were last scanned without reading. To account for such lack of

motivation, on page 6 of the Office Action, the Examiner indicates that there are “numerous scenarios wherein this feature would be useful in Hellebust” and then proceeds to recite a scenario that is clearly not founded in the art but instead only from the Applicant’s disclosure, particularly the discussion on pages 4-5 of the specification submitted by the Applicant. Such reliance on the Applicant’s own disclosure in justifying the rejection is plainly improper and indicative of the use of improper hindsight reasoning and cannot be used to form a *prima facie* case of obviousness. In re Oetiker, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992) (“That knowledge [referring to the impetus to combine elements from various references] cannot come from the applicant’s invention itself.”); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (Taking the inventor’s disclosure “as a blueprint for piecing together the prior art to defeat patentability [is] the essence of hindsight.”).

Accordingly, even if the cited combination of references did disclose or suggest all of the elements recited in the claims (a point which Applicant clearly does not concede), such combination is improper as the Examiner has failed to provide a valid rationale for making such combination.

Reconsideration and withdrawal of the rejection to claims 1-6, 9-11 and 13-18 under 35 USC § 103(a) is respectfully requested.

### Conclusion

In view of the remarks above, Applicant respectfully submits that the application is in proper form for issuance of a Notice of Allowance and such action is requested at an early date.

A fee for a two-month extension of time and the fee associated with a Request for Continued Examination are currently believed to be due. Authorization for payment of such fees by credit card has been provided. If any additional fees are determined to be due, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Eckert Seamans Cherin & Mellott, LLC Deposit Account No. 02-2556.

Respectfully submitted,

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